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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,870	11/01/2001	Joseph A. Sorge	25436/1552	1443

27495 7590 06/16/2004

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EXAMINER

SPIEGLER, ALEXANDER H

ART UNIT	PAPER NUMBER
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1637

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

8/21

Advisory Action

Application No.

10/034,870

Applicant(s)

SORGE, JOSEPH A.

Examiner

Alexander H. Spiegler

Art Unit

1637

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on May 26, 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,6-9 and 11-26.

Claim(s) withdrawn from consideration: _____.

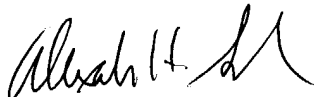
8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: Applicants' have amended the claims to obviate the 102 rejections over Howley and Dayn, and therefore, as amended the claims would require further search and consideration. (see Applicants' response on pages 5 and 6).


Continuation of 5. does NOT place the application in condition for allowance because of the reasons of record, and in view of the non-entry of the after-final amendment, filed on May 26, 2004. Furthermore, Applicant's arguments are not persuasive for the following reasons. First, Howley and Dayn teach the use of agarose gel electrophoresis (which is sieving electrophoresis). Next, the prior art of Jeong and Chung characterize DNase I as a "restriction enzyme", and therefore, absent any definition in the specification of "restriction enzyme" which precludes the characterization of Jeong and Chung; Jeong and Chung's teachings are considered to anticipate the claimed invention. Next, the combination of Bauer, Yuan and Prober teaches that the nucleic acid sample is treated with a substance that cleaves said template nucleic acid without substantially cleaving said synthetic nucleic acid, and then subjecting said treated sample to an analytical procedure, e.g., polyacrylamide gel electrophoresis. Bauer teaches that following the treatment, the sample is transformed, Yuan teaches that following transformation, the sample is confirmed by sequencing, and Prober teaches that sequencing is carried out using polyacrylamide gel electrophoresis. Therefore, the combination of Bauer, Yuan and Prober teach that following the treatment step, the treated sample is subjected to an analytical procedure using polyacrylamide gel electrophoresis. Claim 9 was inadvertently included in the rejection of Bauer, Yuan and Prober. In addition, the combination of Yuan and Prober also teach the claimed methods, since Yuan teaches that following the treatment, the sample is transformed and is confirmed by sequencing, and Prober teaches that sequencing is carried out using polyacrylamide gel electrophoresis. With respect to the 103 rejections of Bauer, Yuan and Prober, and Yuan in view of Prober, Applicant's argue the transformed samples are different than the claimed nucleic acid sample, however, Applicant's do not specifically distinguish how the transformed sample is different from the claimed nucleic acid sample. With respect to the 103 rejection of Chung, Grocke and Bauer, the claims do not require "analysis of the RNA sample", the claims only require that the nucleic acid sample is treated "prior to the analysis of the RNA", but does not specifically require that analysis occurs. With respect to the 103 rejections over Claim 21, Jeong does not teach cleaving template DNA comprising un-modified residues, without substantially cleaving modified residues however, the teachings of Sorge teaches the advantages of cleaving un-modified residues, without substantially cleaving modified residues. Accordingly, the rejections are maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander H. Spiegler whose telephone number is (571) 272-0788. The examiner can normally be reached on Monday through Friday, 7:00 AM to 3:30 PM.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at (571) 272-0782. Papers related to this application may be faxed to Group 1637 via the PTO Fax Center using the fax number (703) 872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alexander H. Spiegler
June 14, 2004



GARY BENZION, PH.D.
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6-14-04